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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,901	09/22/2003	Charles S. Taylor	025925-000200US	2502
20350 7590 05/21/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER PELLEGRINO, BRIAN E	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 05/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,901

Applicant(s)

TAYLOR ET AL.

Examiner

Brian E. Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-21 and 98-101 is/are pending in the application.
- 4a) Of the above claim(s) 98-100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-21 and 101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/9/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 98-100 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 98-100 require the apparatus to be used in combination with a catheter (non-elected invention) not originally required. Election was made **without** traverse in the reply filed on 10/4/06.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 98-100 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,4,6-8,10,11,15 are rejected under 35 U.S.C. 102(e) as being anticipated by McDermott et al. (6312462). Fig. 2 shows a double walled anchor having an inner wall **34** surrounding a primary fluid conduit **14** and an outer wall **36** forming a void **32** between the inner and outer walls. McDermott et al. disclose that a fixation media is included in the void, such as a liquid or gel that hardens to a solid, col. 4, lines 28-56. Fig. 1 illustrates the has a contour that defines lateral fluid conduits **16,18** that can be

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construed to extend in opposite lateral directions. McDermott also discloses the double wall anchor can be collapsed onto a catheter, col. 6, lines 15-20. Fig. 4 shows the device has interconnections **35** between the inner and outer walls.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. '462 in view of Lane et al. (5494029). McDermott et al. is explained supra. However, McDermott fails to disclose a fixation media in the form of a gas or foam. Lane et al. teach the use of a gas or air to fill an anchoring body and also the use of a foam that permits expansion and allows the air to fill it, col. 2, lines 61-67 and col. 4, lines 27-44. It would have been obvious to one of ordinary skill in the art to substitute air and foam as a fixation media to expand an anchoring structure as taught by Lane et al. in the device of McDermott et al. such that it provides a controlled expansion and is easier to utilize or control since the foam is not free flowing.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. '462 in view of Goldstein et al. (5976178). McDermott et al. is explained supra. However, McDermott et al. fail to teach the use of a parylene portion with the device. Goldstein et al. teach that parylene coatings as liners form a smooth lubricious layer, col. 19, lines 41-44,47,52-54. It would have been obvious to one of ordinary skill in the art to utilize a parylene coating as a liner as taught by Goldstein et

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al. and incorporate it with the device of McDermott et al. such that it improves the surface characteristics for improved blood flow.

Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. '462 in view of Cox (5824040). McDermott et al. is explained supra. However, McDermott fails to disclose an expandable stent surrounding the arm and defining the lateral conduit to join the lateral lumen with the primary lumen. Cox teaches (Figs. 3A,3B)a branched prosthesis with a graft **68** connected with a primary fluid conduit **64**. Cox also teaches that stents and liners can be used with the graft, col. 11, lines 59,60. It would have been obvious to one of ordinary skill in the art to incorporate a stent with the graft device of McDermott as it is well known that stent expandable members support the grafts in the vessels and prevent collapse and movement.

Claims 16,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. '462. McDermott is explained supra. However, McDermott fails to disclose quilting walls or regions. It would have been an obvious matter of design choice to modify the interconnection between walls, since applicant has not disclosed that using quilting walls or regions provide any advantage, or solve a stated problem, or are used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the interconnection taught by McDermott or the claimed quilting interconnection in claim(s) 16,17 because both interconnection perform the same function of providing a rigid stable wall portion for the stent-graft.

Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. '462 in view of Wisselink (5984955). McDermott et al. is explained above. However, McDermott et al. fail to disclose placing the prosthesis in the renal branch arteries. Wisselink teaches (Fig. 1a) a prosthesis that utilizes branch vessels for renal arteries. It would have been obvious to one of ordinary skill in the art to modify the prosthesis to be capable of being placed in the renal arteries as taught by Wisselink with the prosthesis of McDermott et al. such that flow can be maintained to the renal arteries, preventing ischemic damage to the organs.

Response to Arguments

Applicant's arguments filed 3/2/07 have been fully considered but they are not persuasive. In response to applicant's argument that McDermott's prosthesis is intended to be used at the bottom or an abdominal aortic region, a recitation of the intended use of the claimed invention *must result in a structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant argues that the branches of McDermott's prosthesis would be not be capable for use within renal arteries. However, this argument is clearly with respect to new claim 101 and as explained above the prosthesis clearly could be modified as taught by Wisselink to allow the main lumen to extend through the aortic aneurysm.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on M-Fr (8:30am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC 3700, AU 3738



BRIAN E. PELLEGRINO
PRIMARY EXAMINER